

## REMARKS/ARGUMENTS

The present application has been carefully reviewed in light of the February 11, 2004 Office Action. In response, as indicated above, Applicant has cancelled claims 4, 5, 13 and 16; and amended claims 1, 6, 11, 14, 51, 59 and 64. In light of these amendments, and the following remarks, Applicant believes that the application is now in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and reexamination the application, as amended.

## CLAIM REJECTIONS

All claims were rejected under 35 U.S.C. §103 under various combinations of "Marathon Foto as described in Applicant's supplemental declaration" (hereinafter "Declaration" or "Marathon Foto"), Greim, Sigel, Hermanns, and Gluck.

As recited in the amended claims, the present invention resides in a process that provides photographs of sporting event participants for inspection, selection and distribution of a computer network. Photographs of substantially the entire body of one or more participants of the sporting event is taken along at least one point of a course or field of the sporting event. Identifying data is associated with each photograph taken. The identifying data is selected from: a number corresponding to a number worn by a participant (see independent claims 1 and 59); a participant's name (see claim 1); a code acquired from a component worn by a participant (see independent claims 1 and 64); and date and time, including hour and minute the photograph was taken (see independent claims 1 and 51).

The participants are informed of the identifying data. The photographs are transferred to a computer network server where each of the photographs is cataloged in a web-site server according to the identifying data. The server is accessed at a location other than the

sporting event, such as by the participants themselves or friends or family members thereof, and the server is searched for a photograph of a particular participant utilizing the identifying data. That is, the individual searching for the photograph of the particular participant enters in the identifying data in the form of the number worn by the participant, the participant's name, the component code worn by the participant, or the date and time the photograph was taken of the participant. Due to the cataloging of each of the photographs in the web-site according to the identifying data, the invention is able to find and display a photograph of the participant for inspection and ordering based upon the identifying data search criteria.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing In re Vaeck, 20 USPQ 2d 1438 (Fed.Cir. 1991)).

As discussed in Applicant's previously filed Supplemental Declaration, traditional sporting event photography involved multiple steps at great cost to the photographer. Pictures were taken, the negatives or photos developed and reviewed for bib numbers, the bib numbers cross-referenced with a listing provided by the event sponsor, paper order forms were mailed to the event participants that were able to be identified which included a thumbnail print, and then the event participant viewing the thumbnail print might elect to purchase one or more photographs by filling out a paper order form (or in some instances an on-line order form) and provide a check or credit card number for payment. As explained by Mr. Wolf, this process was incredibly time

consuming and expensive, especially considering that not all of the event participants purchase photographs. Until Applicant's invention, no sporting event photograph service provided on-line photographs for viewing, inspection and purchase. As explained by Mr. Wolf, the primary reason behind this was that it was not feasible as the event participants would be required to view hundreds or thousands of photographs in order to find their particular photograph and determine if they wanted to order it.

The Examiner has combined this traditional method, which the present invention teaches away from and overcomes its limitations and disadvantages, with the Greim article. Greim discloses a process wherein consumers can drop off a roll of film at any one of thirty thousand retailers around the country and get on-line images of their photos by paying an extra fee. The consumers can, after paying the fee and waiting the necessary time period, access a web-site and gain access to their photos which are password-protected. However, what the Examiner fails to take into consideration is that the Greim process is directed to individuals who have between 12-36 photographs per roll of film. Even in the event of a wedding or the like, there would only be a few dozen pictures to view. Naturally, the individual dropping off the roll of film or the individual gaining access to view his or her wedding pictures or the like would be interested in viewing all of the photographs available as the individual either took all of the photographs of the individual or his or her family, etc. are in the photographs and interest the consumer. Once again, sorting through a few dozen photographs is not overly time consuming.

The Examiner has failed to establish the first basic criteria of a *prima facie* case of obviousness: that there must be some suggestion or motivation in either the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. The mere fact that the references can be combined or modified does not render the resultant

combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. §2143.01 citing In re Mills, 16 USPQ 2d 1430 (Fed. Cir. 1990). Not only is there a lacking of suggestion or motivation in the references to modify or combine the reference teachings, but the references even when combined do not arise to the claimed invention, as amended.

As described in the previously filed Supplemental Declaration of Peter Wolf, many sporting events such as triathalons and marathons have hundreds or even thousands of participants. Many thousands of pictures can be taken of a single event. Providing a password to access a web-site where all of these photographs would be posted (that is the combination of the traditional photography method and Greim) would not appeal to the event participants and would present the very problem the invention overcomes. Event participants would not be willing to spend the time and effort to scan these thousands of pictures of hundreds or thousands of different individuals in the hope of finding their one or more photos taken at the event. The present invention overcomes this major obstacle by associating identifying data with each photograph of competitors/participants of the sporting event. This enables a participant or one interested in obtaining a photograph of the participant to search through the hundreds and thousands of photographs for the perhaps only one photo of that particular competitor. Thus, in a relatively short amount of time the participant can find his or her picture(s), view the picture and make a determination as to whether to purchase the picture all at Applicant's web-site.

As stated by M.P.E.P. §2141.02, in determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Citing, Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 218 USPQ 698 (Fed. Cir. 1983). Further, a prior art reference must be considered in its entirety, i.e., as a whole

including portions that would lead away from the claimed invention. M.P.E.P. §2141.02, citing, W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 US 851 (1984).

Applicant's invention, as recited in the present claims, is intended to overcome the drawbacks of traditional sporting event photography. Taken as a whole, including those portions which would lead away from the claimed invention, the combination of traditional sporting event photography such as Marathon Foto, and Greim do not arise to the present invention and do not render the claimed invention as a whole obvious.

The Office Action properly admitted that the "Declaration"/Greim combination did not explicitly provide for identifying data comprising a code acquired from a component worn by an event participant or triggering a camera when the component passes a predetermined point, which may include a sensor which interfaces with the component. Sigel was combined with the previous combination and asserted to provide these characteristics and features.

Sigel is directed to a photo-finish system for use in races and the like for recording and displaying a time-sequential scene of bodies crossing a plane along a track. When a portion of a human body, for example, passes a sensor, the scan line digital camera takes a sequence of digital image frames representing a line image of the body. As illustrated in FIG. 3 of Sigel, as the first finisher's knee crosses the sensor line, a scan line photograph is taken. Scan line photographs are then taken of the racer's leg, hip, chest, torso, buttocks and remaining portions of the runner's body, such as the backwardly extending leg and foot, as illustrated in FIG. 3. In the illustrated example, approximately 13 scan-line photographs are taken of the single first place finisher. These scan-line images are downloaded to a computer for recall and viewing analysis by judges or the like should the finisher be in question. As such, naturally, the computer system and viewing would take place at the event itself immediately after the finish of the event. In order to identify a

particular competitor, Sigel proposes that the competitors wear a special identification marker having lines or blocks of different colors forming a distinctive combination of the like. Sigel also discusses the possibility of optical character recognition for reconstructing and reading the number on the contestant's jersey if the contestant cannot otherwise be identified due to the scan-line images. Although Sigel is addressed to triggering a camera when a race participant passes a sensor, typically placed at the finish line, Sigel in no way is directed to a process for providing event photographs of race participants for inspection, selection and distribution. As such, Sigel is completely non-analogous to the present invention as the present invention is not directed to photo-finishes and Sigel is not directed to providing event photographs to participants for inspection and ordering.

In *Ruiz v A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), it was held that "while the references need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability must be "clear and particular." In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. [Emphasis added]. In the instant office action, the showing of combinability is far from "clear and particular."

"For a proper obviousness combination, the prior art references must provide a suggestion or motivation to make such a combination." Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 168, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) citing Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 934 15 USPQ2d 1321, 1323 (Fed. Cir. 1990).

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But obviousness "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or

suggestion supporting the combination." ACS Hosp. Sys. Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.*

The combinability of the Greim, "Declaration" and Sigel references is far from "clear and particular." These references do not provide a suggestion or motivation to make such a combination. There would be no incentive or motivation to combine these references as the Greim methodology simply is not adequate for sporting event photography as disclosed by Applicant in his Declaration and a scan-line time-sequential series of photographs is simply inadequate and not desirable for the inspection and ordering of event photographs of the participant for memento sake and the like to which the present invention is directed to. Thus, the combination of the references, Applicant believes, is improper.

It is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. Life Technologies, Inc. v. Clontech Laboratories, Inc., 56 USPQ 2d 1186 (Fed. Cir. 2000). Of course, the Examiner cannot use Applicant's claims as a framework from which to pick and choose among individual references to recreate the claimed invention as such hindsight is impermissible and strictly forbidden.

Nonetheless, Sigel, even when improperly combined with "Declaration" and Greim, does not overcome the deficiencies of this combination to arise to the recitations of the claimed invention in the amended independent claims. Sigel does not disclose associating identifying data (as discussed above) with each photograph taken, informing the participants of the identifying data, cataloging each of the photographs in a web-site server according to the identifying data and accessing the server at a location other than the sporting event and searching for a photograph of a particular participant using the identifying data and displaying a photograph of the participant for inspection and

ordering. These steps, considered as a whole, are simply not disclosed in these three references.

In the Office Action, it was properly admitted that the combination of Declaration/Greim/Sigel did not explicitly provide that the component worn by the participant, that triggers the camera, is an inductive circuit or an active component that includes an electronic device having a transmitter, as recited in claims 10, 11, 12, 69, 70 and 71. Thus, the Office Action combined Hermanns with this combination in an attempt to reject these claims. Hermanns discloses a system for determining when the competitors in a race finish the line by fitting each competitor with a transmitter which transmits to receiving antennas at the finish line, the moment that the competitor crosses the finish line.

In the background of Hermanns, Hermanns discusses the disadvantages of photo-finishes, such as Sigel, as such evaluations always take time. Thus, Hermanns and Sigel actually teach away from one another and would be considered non-analogous and not properly combinable. Furthermore, there is no discussion whatsoever in Hermanns of triggering a camera or the like upon the passing of the inductive circuit or active component. In fact, as just discussed above, Hermanns actually teaches away from such photo-finishes and the use of cameras.

Thus, to combine Sigel and Hermanns would require that the principle of operation of one of the references be modified. As the MPEP states: "If the proposed modifications or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP §2143.01 (citing In re Ratti, 123 USPQ 349 (CCPA 1959)); see also MPEP §2143.01 (citing In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984)) ("If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Here, since combining



the teachings of Sigel with Hermanns would change the principle of operation of Hermanns and render it unsatisfactory for its intended purpose-the elimination of photo finishes and triggered cameras, the teachings of these references are not sufficient to render the pertinent claims obvious. Hence, as there is no motivation or suggestion to modify Hermanns in view of Sigel as proposed by the Office Action, there is an improper combination of references and the claims are unobvious and patentable as supported by the MPEP and case law.

The Office Action correctly stated that the combination of Declaration/Greim did not explicitly provide that the identifying data comprise the date and time the photograph was taken or that an approximate time could be used to search for a particular photograph. The Office Action combined Gluck with these references, Gluck as stated in its Abstract is directed to a system and method for producing and distributing personalized photographic souvenirs for spectators of an event. Pan-and-tilt camera systems are used to take orderly, indexed series of photos of the spectators according to a predetermined mapping algorithm which masks a particular location of venue to a virtual sector (such as by seat number and section of an indoor stadium). Spectators can also be photographed while in a line or the like and the photographs searched for and retrieved at the sporting event site by such location or time when the picture was taken. Vendors are sent with photographs and souvenirs to the spectators within the locations (such as the seat number) to offer the photographic souvenirs. Alternatively, the spectators approach a walk-up window at the sporting event and obtain their photos based upon their seat number, location when the photograph was taken, and/or time or number presented when the photograph was taken.

Gluck is in no way related to the process and methodology of photographing event participants/competitors of a sporting event along a course. Gluck is specifically directed to such event spectators who are seated or immobile such as in a line or posing at a particular location.

However, even if a spectator is armed with this information, Gluck leaves them no opportunity to access a server at a location other than the sporting event and search for their photograph for inspection and ordering. Instead, the only alternative discussed in Gluck is a spectator approaching a walk-up window available at the assembly site at the sporting event and conveying this information to a vendor who would look up the photograph and present it to the spectator for inspection and ordering.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing In re Royka, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 165 USPQ 494, 496 (CCPA 1970). Gluck simply fails to remedy the deficiencies of the aforementioned references. Gluck is not related to a process for providing event photographs of participants or competitors of the sporting event. Gluck does not teach whatsoever of taking such photographs along at least one point of a course of the sporting event. Gluck does not inform sporting event competitors of the identifying data. Gluck does not teach or disclose or even infer accessing the server at a location other than the sporting event. Thus, Gluck, and its combination with the aforementioned references, does not teach or suggest all of the claim limitations of the independent claims 1, 51, 59 and 64.

Once again, it appears that the Examiner has ignored the references in their entirety and selectively taken certain teachings or portions of each reference and combined them in an attempt to recreate Applicant's claimed invention. Of course, this is impermissible. Notwithstanding this attempt, in light of the currently amended claims, Applicant respectfully asserts that this approach has failed to render the amended claims obvious for the reasons discussed above.

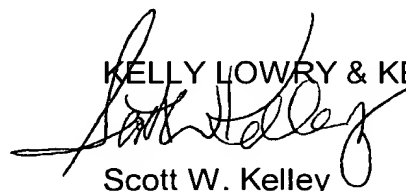
None of the cited references are at all directed to the solving of the problem of traditional sporting event photography. None of the cited

references disclose a system or process for providing event photographs of participants wherein identifying data, as claimed, is associated with each photograph which are cataloged in a web-server and accessed at a location other than the sporting event and searched for a photograph of a particular participant utilizing the identifying data for display and ordering. As discussed above, and in previous Declarations and responses, the present invention enables hundreds and thousands of photographs of a sporting event (such as a marathon, triathlon, bike race, etc.) to be posted and searched by the participants for finding perhaps their only photograph among the tens of thousands that were taken that day. Without the present invention, posting of photographs with such events is extremely problematic and simply not capable of commercial success. In the rare case where the prior art does not appreciate the existence of the problem solved by the invention, the applicant's recognition of the problem is, in itself, strong evidence of the non-obviousness of the invention. In re Nomiya et al., 184 USPQ 607, 612-613 (CCPA 1975).

#### CONCLUSION

From the foregoing amendments and remarks, Applicant respectfully asserts that the presently pending claims are not rendered obvious in light of the cited references and are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

  
KELLY LOWRY & KELLEY, LLP  
Scott W. Kelley  
Registration No. 30,762

SWK/kr  
6320 Canoga Avenue, Suite 1650  
Woodland Hills, California 91367  
(818) 347-7900